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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,200	11/20/2003	Marcus Dehlin	1988.68755	9819

7590 10/18/2006

GREER, BURNS & CRAIN, LTD.
Suite 2500
300 South Wacker Drive
Chicago, IL 60606

EXAMINER	
PICKETT, JOHN G	

ART UNIT	PAPER NUMBER
3728	

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/718,200	DEHLIN ET AL.	
	Examiner	Art Unit	
	Gregory Pickett	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 July 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-17* is/are pending in the application.

4a) Of the above claim(s) *14-17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *14-17* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7/31/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action acknowledges the applicant's amendment filed 31 July 2006. Claims 1, 3-17 are pending in the application. Claim 2 has been canceled.

2. Amended claims 14-17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 14-17 and the invention originally claimed are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process, such as leaving the slidable insert uncoated.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 14-17 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

4. In light of the applicant's amendment, the rejection of claims 1-17 under 35 U.S.C. 112, 2nd paragraph, is withdrawn.

Claim Rejections - 35 USC § 102

5. Claims 1, 3-5, 7, 9, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Jones et al (US 6,752,272 B2; hereinafter Jones).

Claim 1 is a product-by-process claim. Jones discloses a child-resistant carton package comprising an outer sleeve **1**, an insert **3** carrying a packaged product, and a locking mechanism **13/24/25** or **10**. Jones anticipates a fiber-based board (paperboard) reinforced with a polymer to increase resistance to tearing (see Col. 4, lines 10-14 and Col. 6, lines 9-13). Jones anticipates an extrusion-laminated, and therefore coated, board (Col. 6, lines 23-25).

Claim 3: Jones anticipates polyester (see Col. 6, lines 16-19).

Claim 4: Jones anticipates polyesters, of which PET is a subset.

Claim 5: Jones anticipates coating on both sides (Col. 6, line 11).

Claim 7: Jones anticipates the coating on both the sleeve and the insert (Col. 4, lines 10-14).

Claim 9: The laminate of Jones is delaminable.

Claim 11: Jones discloses a hole when item **13** is depressed.

Claim Rejections - 35 USC § 103

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones, as applied to claim 1 above, and further in view of Holbert et al (US 2003/0148110 A1; hereinafter Holbert).

Jones discloses the claimed invention except for the inner reinforcement layer. Holbert discloses a paperboard/polymer laminate with an inner reinforcement layer **14**, which may be polyester (see paragraph [0021]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the board of Jones with an inner reinforcement layer as taught by Holbert in order to improve tear resistance (see Holbert paragraph [0010]).

7. Claims 8, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones, as applied to claim 1 above, and further in view of Schwenk (US 3,654,842).

Jones discloses the claimed invention except for the polymer shield and heat-sealing with seam overlapping.

Schwenk discloses a polymer shield (Figure 5) and heat-sealing with seam overlapping (Figure 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the carton of Jones by heat-sealing as taught by Schwenk in order to form a more durable bond.

Allowable Subject Matter

8. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

10. Applicant's arguments filed 31 July 2006 have been fully considered but they are not persuasive. Applicant's arguments appear to attempt to define the claim as a product-by-process claim.

Extrusion lamination covers a substrate layer with an additional layer of material and therefore may be considered to "coat" the substrate layer. Applicant offers no evidence for the characterization that Jones produces more layers than disclosed; Jones itself certainly does not present this arrangement. Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between

the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983)

Further, applicant's extrusion coating results in a polymer layer on the fiber-based board (see applicant's specification at page 3, lines 30-34). The extrusion lamination (considered a coating) disclosed in Jones also produces a polymer layer on the fiber-based board. The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. (Same cite as above).

Even assuming, *arguendo*, that the process of Jones were to produce an additional layer, the applicant uses the open terminology "comprising", and the fact that Jones discloses additional structures not claimed by the applicant are irrelevant since Jones does disclose a polymer layer extrusion laminated to, and therefore coating, the fiber-based board.

Moreover, the structures **13/24/25** of Jones function as a locking mechanism (see Col. 8, lines 42-48 and Col. 10, lines 12-17) and therefore meet the limitation claimed by the applicant.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Greg Pickett
Examiner
15 October 2006

Mickey Yu
Supervisory Patent Examiner
Group 3700